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EXAMINER

SMITH, JEFFREY A

ART UNIT	PAPER NUMBER
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3625

DATE MAILED: 10/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

10/010,993

Applicant(s)

LYNCH, GERARD ALAN

Examiner

Jeffrey A. Smith

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 June 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 November 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 6/16/05.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on June 16, 2005 has been entered.

Response to Amendment

The Response filed June 16, 2005 has been entered and considered.

Claims 1-10 are pending.

Claims 1 and 4 are currently amended.

An action on the merits follows.

Information Disclosure Statement

The information disclosure statement filed June 16, 2005 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent

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literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

Reference "AT" has not been considered since no copy could be located in the file.

Regarding references "AU"-"AW": the Examiner has only considered the English Abstracts provided. The full foreign documents have not been considered as such full documents have not been provided.

Drawings

The drawings are objected to because they contain roughly drawn reference numerals, figure legends, and lead-lines; Fig. 4B contains improper shading. Additionally, Applicant is reminded to observe required margins.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the

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appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Specification

The abstract of the disclosure is objected to because it appears that "one or modules" (line 5) should read as --one or more modules--.

Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1 (and elsewhere in dependent claims): it is unclear whether the recited "pictures" in the phrase "set of pictures" is a reference to the "selectable images" set forth in line 5. It appears that Applicant has intended at line 6, for example, that "a set of pictures" should be read as --a set of selectable images--. This interpretation is, however, speculative based upon the full disclosure..

For examination purposes, the Examiner has considered references to "set of pictures" to read as --set of selectable images--. Applicant should comment on the intent of these references and amend the claims consistent with the intent.

Claims 1-10 are rejected under 35 U.S.C. 112, second paragraph, as being incomplete for omitting essential steps, such omission amounting to a gap between the steps. See MPEP § 2172.01. The preamble sets forth "[a] method of delivering,

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in the form of selectable images, a plurality of auction items of a selected seller to a browser of a client computer system". The Examiner notes, however, that the body of the claim fails to recite an active step which results in the goal set forth by the preamble. Although a main program is delivered to the requesting client browser, such main program itself does not comprise the selectable images as such. The main program merely comprises a picture displaying module having functionality to obtain such images. There is no step recited which actually results in the delivery of images as per the preamble.

Moreover, and as a result of the omission noted above, the scope of the claim is unclear because the body of the claim is not commensurate with the preamble in that the execution of the steps of the body of the claim does not result in achieving the goal set forth in the preamble. Applicant is required to comment on the intent of the claim and to amend the claim such that its scope is commensurate with the intent.

For examination purposes, the Examiner has considered an additional step in claim 1 as: --obtaining said set of pictures of the selected sellers auction items--

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

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Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention lacks patentable utility.

The invention, as claimed, lacks utility because it fails to set forth active steps which, when completed, achieve the utility recited. The omission of a step which results in the delivery of selectable images (as set forth in the preamble) gives rise to the recitation of an invention which lacks utility for its recited utility or purpose.

Claims 1-10 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As an initial matter, the United States Constitution under Art. I, §8, cl. 8 gave Congress the power to "[p]romote the progress of science and useful arts, by securing for limited times to authors and inventors the exclusive right to their respective writings and discoveries". In carrying out this power, Congress authorized under 35 U.S.C. §101 a grant of a patent to "[w]hoever invents or discovers any new and useful process, machine, manufacture, or composition or matter, or any new and useful improvement thereof." Therefore, a fundamental

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premise is that a patent is a statutorily created vehicle for Congress to confer an exclusive right to the inventors for "inventions" that promote the progress of "science and the useful arts". The phrase "technological arts" has been created and used by the courts to offer another view of the term "useful arts". See *In re Musgrave*, 167 USPQ (BNA) 280 (CCPA 1970). Hence, the first test of whether an invention is eligible for a patent is to determine if the invention is within the "technological arts".

Further, despite the express language of §101, several judicially created exceptions have been established to exclude certain subject matter as being patentable subject matter covered by §101. These exceptions include "laws of nature", "natural phenomena", and "abstract ideas". See *Diamond v. Diehr*, 450, U.S. 175, 185, 209 USPQ (BNA) 1, 7 (1981). However, courts have found that even if an invention incorporates abstract ideas, such as mathematical algorithms, the invention may nevertheless be statutory subject matter if the invention as a whole produces a "useful, concrete and tangible result." See *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* 149 F.3d 1368, 1973, 47 USPQ2d (BNA) 1596 (Fed. Cir. 1998).

This "two prong" test was evident when the Court of Customs and Patent Appeals (CCPA) decided an appeal from the Board of

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Patent Appeals and Interferences (BPAI). See *In re Toma*, 197 USPQ (BNA) 852 (CCPA 1978). In *Toma*, the court held that the recited mathematical algorithm did not render the claim as a whole non-statutory using the Freeman-Walter-Abele test as applied to *Gottschalk v. Benson*, 409 U.S. 63, 175 USPQ (BNA) 673 (1972). Additionally, the court decided separately on the issue of the "technological arts". The court developed a "technological arts" analysis:

The "technological" or "useful" arts inquiry must focus on whether the claimed subject matter...is statutory, not on whether the product of the claimed subject matter...is statutory, not on whether the prior art which the claimed subject matter purports to replace...is statutory, and not on whether the claimed subject matter is presently perceived to be an improvement over the prior art, e.g., whether it "enhances" the operation of a machine. *In re Toma* at 857.

In *Toma*, the claimed invention was a computer program for translating a source human language (e.g., Russian) into a target human language (e.g., English). The court found that the claimed computer implemented process was within the "technological art" because the claimed invention was an operation being performed by a computer within a computer.

The decision in *State Street Bank & Trust Co. v. Signature Financial Group, Inc.* never addressed this prong of the test. In *State Street Bank & Trust Co.*, the court found that the

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"mathematical exception" using the Freeman-Walter-Abele test has little, if any, application to determining the presence of statutory subject matter but rather, statutory subject matter should be based on whether the operation produces a "useful, concrete and tangible result". See *State Street Bank & Trust Co.* at 1374. Furthermore, the court found that there was no "business method exception" since the court decisions that purported to create such exceptions were based on novelty or lack of enablement issues and not on statutory grounds. Therefore, the court held that "[w]hether the patent's claims are too broad to be patentable is not to be judged under §101, but rather under §§102, 103 and 112." See *State Street Bank & Trust Co.* at 1377. Both of these analysis goes towards whether the claimed invention is non-statutory because of the presence of an abstract idea. Indeed, *State Street* abolished the Freeman-Walter-Abele test used in *Toma*. However, *State Street* never addressed the second part of the analysis, i.e., the "technological arts" test established in *Toma* because the invention in *State Street* (i.e., a computerized system for determining the year-end income, expense, and capital gain or loss for the portfolio) was already determined to be within the technological arts under the *Toma* test. This dichotomy has been recently acknowledged by the Board of Patent Appeals and

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Interferences (BPAI) in affirming a \$101 rejection finding the claimed invention to be non-statutory. See *Ex parte Bowman*, 61 USPQ2d (BNA) 1669 (BdPatApp&Int 2001).

In the present application, there is no specific and non-trivial application of technology in the bodies of these claims (even as interpreted for examination purposes). It is noted that such claims recite steps which receive a request, deliver a main program to a browser, and, as interpreted, obtain a set of selectable images. However, such steps are considered a trivial application of technology because they amount to the mere transfer of data, rather than, for example, the transformation of data. Further, it is noted that the functionality of the main program is never recited as being specifically applied in the method.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

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Claims 1-3, and 5-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Trubey et al. (US 2002/0077930 A1) in view of Hess et al. (U.S. Patent No. 6,058,417).

Trubey et al. discloses a method of delivering, in the form of selectable images, a plurality of items of a selected seller to a browser of a client computer system (par. 0008).

The method comprises receiving, at an auxiliary server (par. 0061), a request from a client browser for a main program (par. 0095); and delivering the main program to the requesting client browser (par. 0095).

The Examiner notes a "dynamic pallet" embodiment which requires that the browser support Java, Flash, Microsoft Common Language Runtime, and/or DHTML (par. 0092). In this embodiment, a main program is configured to received seller specific information ("information in the request code placed therein by the content site": par. 0095) and to load and activate one or more modules including a picture displaying module for displaying selectable images (par. 0070). The picture displaying module is configured to obtain a set of pictures of the selected seller's items, based on the received seller specific information (par. 0093), to moveably display, on the client browser, a set of pictures, showing the selected seller's

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items (par. 0077), and to receive a user selection of a picture being displayed (par. 0104) and to redirect the client browser to an item document at a site associated with the selected image (par. 0108).

Trubey et al. does not disclose that such items are auction items or that such site is an auction site.

Hess et al., in a similar method (col. 5, lines 4-31; col. 9, lines 47-63; and Fig. 9), the implementation of a "Gallery" of items for sale for presentation to prospective purchasers responsive to a purchaser's requests and/or queries. Hess et al. teaches that such Gallery may be presented to a user in e-commerce environments, such as online shopping sites, auctioning sites, and the like (col. 3, lines 65-col. 4, line 5).

It would have been obvious to one of ordinary skill in the art to have provided the method of Trubey et al. for use in an auction site environment (as taught by Hess et al.) in order to have facilitated person-to-person commerce (such as an auction of the type taught by Hess et al.) by providing prospective buyers the ability to quickly preview items for sale (col. 2, lines 10-15).

In the combination of Trubey et al. and Hess et al., the functionality of receiving a request from a client browser for a main program would include receiving the request from an auction

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item document obtained from an auction site (in a manner similar to that disclosed by Trubey et al. (par. 0067)). Likewise, the set of selectable images would be displayed on the auction item document obtained from the auction site (in a manner similar to that disclosed by Trubey et al. (par. 0067)).

Trubey et al. discloses moveable display of the set of pictures horizontally in the client browser graphical window (par. 0075).

Trubey et al. discloses that the main program is configured to load and activate a categories module that maintains a set of categories available on the site from the specified seller (par. 0083).

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Trubey et al. (US 2002/0077930 A1) and Hess et al. (U.S. Patent No. 6,058,417), as applied to claim 1 above, and further in view of Official Notice regarding controllable speed being controlled by a current position of a pointing device.

Regarding claim 4, the combination of Trubey et al. and Hess et al. provides a module configured to moveably display the set of pictures at a controllable speed (Trubey et al.: par. 0077).

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The combination does not teach that the module is configured with the functionality wherein the controllable speed is controlled by a current position of a pointing device connected to the client computer.

The Examiner notes that the missing functionality is not recited as an active step of the method in which this functionality is positively invoked. The method recited is directed to a method of delivering the program and associated module, rather than a method of using such program and associated module. Accordingly, in a method of delivering, as recited, the functionality of the delivered program and associated module is of little patentable consequence in otherwise distinguishing the method of delivering recited and the method of delivering already taught by the combination of Trubey et al. and Hess et al.

Nonetheless, the Examiner takes Official Notice that such functionality is a well-known technique in the presentation of images for perusal by a client computer user. Such technique allows such user to move a cursor (receiving signals from a pointing device (e.g. a mouse) to "slow down" or "speed up" the automatic scrolling of images presented in a browser presentation--especially flash (Macromedia) enabled browser presentations.

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It would have been obvious to one of ordinary skill in the art to have provided the combination of Trubey et al. and Hess et al. to have included controllable speed of the type taught by the Official Notice in order to have allowed the client user to have perused the display of dynamic item images (already taught by Trubey et al.) at a comfortable client-user pace. Such pace would have allowed the client user to have quickly skipped past items in which they have no interest or to have stopped at items in which they have great interest providing an opportunity for deliberate study of such items.

Response to Arguments

Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Dustin et al. (U.S. Patent No. 6,496,857 B1) discloses delivering targeted, enhanced advertisements across electronic networks. For example, enhanced ads for items in an online

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auction sited related to the subject of an original advertisement may be presented using rich media in a banner advertisement (col. 3, lines 14-17; col. 3, line 57-col. 4, line 48; and col. 5, lines 9-17).

"Lot21 Has Done it Again!: Pushing Rich Media to New Levels of Interactivity With Real-Time Auction Information", PRNewswire/NEWSdesk, 25 May 1999, retrieved [online] from the Internet at <<http://www.findwealth.com/lot-has-done-it-again-55510pr.html>> [printed: 01 October 1 2005] discloses a Macromedia Generator-enhanced ad banner which transmits up to 50 live auctions in each banner in a rich media presentation.

"Auctiva: Powerful solutions for online sellers: Help: Showcase Frequently Asked Questions (FAQ)", 01 December 2000, retrieved [online] from the Internet at <http://web.archive.org/web/20001201225300/auctiva.com/help/sh_FAQ.asp> [printed: 01 October 2005] discloses details of the Auctiva Showcase service.

Steiner, Ina: "Vendio Announces New Merchandising Tool and Positive Financials", AuctionBytes.com, 15 April 2004, retrieved [online] from the Internet at <<http://www.auctionbytes.com/cab/abn/y04/m04/i15/s01>> [printed: 02 October 2005] discloses the announcement of a new Gallery toll designed to help auction sellers cross-sell to customers.

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"Auctiva: Powerful solutions for online sellers: Press Room: Auctiva News: Auctiva launches flagship service with Auctiva Showcase", Auctiva.com, 05 October 2000, retrieved [online] from the Internet at <<http://web.archive.org/web/20010620195031/auctiva.com/news/rel20001005.asp>> [printed: 02 October 2005] discloses the launch of its Auctiva Showcase service.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is (571) 272-6763. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on (571) 272-7159. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffrey A. Smith
Primary Examiner
Art Unit 3625

jas

PTO-892 (Cont.)

Non-Patent Documents

(Ref. U) "Lot21 Has Done it Again!: Pushing Rich Media to New Levels of Interactivity With Real-Time Auction Information", PRNewswire/NEWSdesk, 25 May 1999, retrieved [online] from the Internet at <<http://www.findwealth.com/lot-has-done-it-again-55510pr.html>> [printed: 01 October 1 2005].

(Ref. V) "Auctiva: Powerful solutions for online sellers: Help: Showcase Frequently Asked Questions (FAQ)", 01 December 2000, retrieved [online] from the Internet at <http://web.archive.org/web/20001201225300/auctiva.com/help/sh_FAQ.asp> [printed: 01 October 2005].

(Ref. W) Steiner, Ina: "Vendio Announces New Merchandising Tool and Positive Financials", AuctionBytes.com, 15 April 2004, retrieved [online] from the Internet at <<http://www.auctionbytes.com/cab/abn/y04/m04/i15/s01>> [printed: 02 October 2005].

(Ref. X) "Auctiva: Powerful solutions for online sellers: Press Room: Auctiva News: Auctiva launches flagship service with Auctiva Showcase", Auctiva.com, 05 October 2000, retrieved [online] from the Internet at <<http://web.archive.org/web/20010620195031/auctiva.com/news/rel20001005.asp>> [printed: 02 October 2005].